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09/516,112	03/01/2000	Hiroyuki Fujiyoshi	862.C1854	3021

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EXAMINER

JAROENCHONWANIT, BUNJOB

ART UNIT PAPER NUMBER

2143

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/516,112

**Applicant(s)**

FUJIYOSHI, HIROYUKI

**Examiner**

Bunjoo Jaroenchonwanit

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-26, 28-40, 50-66, 68-80, 84-86, 90-92 and 94-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-26, 28-40, 50-66, 68-80, 84-86, 90-92 and 94-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAIL ACTONS

1. Applicant is advised that the remark filed 8/23/04, contain erroneous statement, the cancelled claims are, 1-9, 27, 41-49, 67, 81-83, 87-89 and 93. Consequently, claims 10-26, 28-40, 50-66, 68-80, 84-86, 90-92 and 94-96 are pending for examination, the rejection cited as stated below.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to adequately teach how to make/or use the invention, i.e., failing to disclose how the object can be access without using object name and path as claimed.

4. Applicant's disclosure is insufficient to allow one of ordinary skill in the art to make or use the invention without undue experimentation because applicant did not adequately disclose the necessary apparatus to perform the claimed method. See In re Gunn, 190 USPQ 402, 406 (CCPA 1976.) In contrary, the amendment supported citation implicitly teaches the use of folder, i.e., path, and version, e.g. implied name, since conventionally, objects were accessed by using arbitrary (object or file) name or arbitrary name and its version number, thus omission of using name in the disclosure. Thus, using unconventional inventive concept, i.e., access object without using name and path, would required a clear and concise teaching to enable one ordinary skill in the art to make and use the invention without undue experimentation. Applicant clearly taking advantage and claiming an implicit absentee terms, without specific teaching, how it can be done distinctively from conventional art.

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5. Claims 10-26, 28-40, 50-66, 68-80, 84-86, 90-92 and 94-96 are rejected under 35

U.S.C. 112, first paragraph, for reason set forth in the objection to the specification.

It is suggested that applicant could overcome 112/first paragraph rejection by providing a suitably detailed system diagram (with appropriate cross-indexing in the detailed description to reference numerals on said system diagrams.) No new matter should be added.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 10-26, 28-40, 50-66, 68-80, 84-86, 90-92 and 94-96 are rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and

distinctly claim the subject matter which applicant regards as the invention. The aforementioned

claims contain negative limitations, which attempted to claim the invention by excluding what

the inventors did not invent rather than distinctly, and particularly pointing out what they did

invent. The court held such negative limitations indefinite (MPEP 2173.05(i)).

8. The text of those sections of Title 35, U.S. Code § 102 (e) and 103 (a) not included in this action can be found in a prior Office Action.

9. Claims 10, 16-24, 26, 28-31, 37-40, 50, 56-64, 66, 68-71, 77-86, 90-92 and 94-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirai et al (US.6, 466,968) and Uchida et al (US. 6,327,610).

10. As to claims 10, 20, 50, 60 and 94, Shirai discloses means, steps and instructions for generating an attached file (Fig. 22, 301c, Fig. 20, S54, Col. 12, 25-32) (*i.e., a designating step*

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*of designating a desired object to be attached to electronic mail*); a designator unit for designate access method (Fig. 22, 301i; Col. 13, lines .42-44) (*i.e., an acquisition step of acquiring access information relating to the object designated at said designating step*); for including access information in the e-mail messages, for using as instruction, by e-mail recipient, to access and/or handling the attachment file (Fig. 4, 19; Col. 5, lines 43-52; Col. 12, lines 32-40) (*i.e., mail information generating step of generating electronic mail information in which the access information acquired at said acquisition step constitutes part of the electronic mail*); an extraction step of extracting the access information contained in electronic mail that has been received (Shirai, Col. 14, lines 50-51); an object access step of accessing an object based upon the access information extracted at said extraction step (Shirai, Col. 14, lines 52-53); and a display step off presenting a display that corresponds to the object based upon a content of the object accessed at said access step (Shirai, Col. 15, lines 40-45); generating e-mails, including attachment files and instructions how to access the attachment files (*i.e., a generating step of generating electronic mail information which includes access information relating to an object to be attached to electronic mail*) (Shirai, See Fig. 4A, 401-405; Fig. 4B, 407-408; Fig. 5, S11-S14); communicating the e-mails and the attachment files (*i.e., a communication step of sending and receiving the electronic mail information generated at said generating step*) (Shirai, Fig. 3B, 301b, 302305, 306b; Fig. 5, S16; Fig. 6, S24); and means, steps and instructions for access the attachment files based on the access information (Shirai, Fig. 4, 405, 407-408; Fig. 6, S25), (*i.e., an access step of accessing the object based upon the access information contained in the electronic mail information received via said communication step*).

Shirai does not explicitly disclose, an inclusion of access information that permitting users to access objects in a storage, as pointed out by the applicant in the remark and supported by the specification in page 10, lines 4-8. In light of the supported passages, applicant referred to the use of access key, which is sent to email recipients for accessing objects stored in a corresponding storage. In the same field of endeavor, Uchida motivated by attempting to avoid a numerous problems that may occur as a result of excessive bandwidth consumption, which often caused from delivery a large object via an email attachment, teaches an improving system for delivering large objects via email. Rather than employing a conventional conceptual, e.g., directly attaches a large object to an email, Uchida embedded an access code for accessing information in an email and delivered the email to the intended recipients. The recipients then used the access code to access the corresponding stored object (Col. 3, lines 2-6; Col. Fig. 3, 306; Fig. 4, 412-415). Thus, whoever received an access code would be able to access the corresponding object, regardless of pre-registration for accessing the object. Thus, taking advantage from Uchida's teaching, to improve Shirai's system, to minimized bandwidth consumption cost, would have obvious to one of ordinary skill in the art at the time of the invention was made. Because such improvement would enable one to control amount of e-mail transmission over the network, preventing enormous traffics, especially traffics generated from e-mails attachments, thereby minimizing utilization and operation cost let alone further strengthen e-mail security and user privacy.

11. As to claims 21 and 61, Shirai-Uchida discloses means, steps and instructions for generating an attached file (Fig. 22, 301c, Fig. 20, S54, Col. 12, 25-32) (*i.e., a designating step of designating a desired object to be attached to electronic mail*). Further, Shirai discloses a

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means, steps and instructions for a designator unit for designate access method (Fig. 22, 301i; Col. 13, lines 42-44) (*i.e., an acquisition step of acquiring access information relating to the object designated at said designating step*). Furthermore, Shirai discloses a means, steps and instructions for including access information in the e-mail messages, for using as instruction, by e-mail recipient, to access and/or handling the attachment file (Fig. 4, 19; Col. 5, lines 43-52; Col. 12, lines 32-40) (*i.e., mail information generating step of generating electronic mail information in which the access information acquired at said acquisition step constitutes part of the electronic mail*).

12. As to claims 22 and 62, Shirai-Uchida discloses means, steps and instructions for generating attachment file and designating access method (Shirai, Col. 5, lines 43-56) (*i.e., mail information generating step generates an attachment file which includes the access information acquired by said acquisition step and attaches the generated attachment file to electronic mail that is to be transmitted*).

13. As to claims 23 and 63, Shirai-Uchida discloses means, steps and instructions for merging an attachment file and access method into e-mail message (Shirai, Col. 5, lines 57-61) (*i.e., said mail information generating step affixes the access information, which has been acquired at said acquisition step, to a main body of electronic mail that is to be transmitted*).

14. As to claims 24 and 64, Shirai-Uchida discloses means, steps and instructions for generating an URL for accessing an attachment file (Shirai, Fig. 4B; Col. 5, lines 56-58) (*i.e., the access information includes information indicating a storage location of the object, which has been designated at said designating step, in the system*).

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15. As to claims 26 and 66, Shirai-Uchida discloses means, steps and instructions for allowing e-mail users to set access method via e-mail attached file edit window (Shirai, Fig. 19; Col. 4, lines 52-53) (*i.e., acquisition step includes a setting step of allowing a user to set access information via a prescribed user interface*).

16. As to claims 18-19, 28-29, 39, 40, 58, 59, 68-69 and 79-80, Shirai-Uchida discloses attachment access information includes an access key for logging in the storage location (Uchida, Col. 3, lines 2-6; Col. Fig. 3, 306; Fig. 4, 412-415).

17. As to claims 16-17, 37-38, 56-57, 77 and 78, Shirai-Uchida discloses means, steps and instructions for extracting access method (Shirai, Col. 20, lines 8-9) (*i.e., said extraction step extracts the access information from a file that has been attached to electronic mail*).

18. As to claims 30, 70, Shirai-Uchida discloses means, steps and instructions for transmitting e-mail, attachment and other desirable information to e-mail recipients (Shirai, Fig. 1, 103-104) (*i.e., communication step transmits the electronic mail information, which has been generated at said generating step, to an information processing apparatus that has been designated*).

19. As to claims 81-92, as discussed in the above paragraphs, Shirai-Uchida-Uchida discloses the invention substantially, as claimed, including attachment access information, sending access code to subscribers, i.e., registered users, and preventing non subscribers to access the information, by sending access code to its subscribers only. Shirai-Uchida-Uchida does not explicitly disclose *setting whether or not to provide the access information, password, to unregistered user*. However, having a system to decide whether or not to send access information to a specific users, e.g., unregistered, would have been obvious to one of ordinary



skill in the art at the time of the invention was made that was a matter of design choice that clearly depended on applications' requirements. Because allowing sending access information to all users, (e.g., subscribers and non-subscribers), the system would be capable of sending e-mails to new users, which could be used and most required for advertising and products marketing.

20. Claims 11-15, 25, 32-36, 51-55, 65 and 72-76, are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirai-Uchida, as applied to claims 10, 20, 41, 50 and 60 above, and further in view of Holtz (US. 6,433,800).

21. As to claims 11-15, 25, 32-36, 51-55, 65 and 72-76, Shirai-Uchida discloses the invention substantially as claim but fails to disclose *a thumbnail of documents, and displaying an icon corresponding to an electronic mail application; and designating a desired by dropping the document on to the icons*. However, in an analogous art, to improve over a conventional system (Holtz, Col. 2, lines 28-52), Holtz teaches a graphical method invocation method, and associated method for computer system, which capable of displaying list of e-mails and attached objects in at a glance form, icons, and capability of allowing objects to be designated to the icons and list by way of drag and drop (Holtz, Fig. 2, items 54, 44, 46 and 48; Col. 25, lines 3-16; Fig.6-8 and corresponding details in Col. 6, line 62-Col. 7, line 40). Thus, taking advantage of Holtz suggestions would have been obvious to one of ordinary skill in the art at the time of the invention was made. Because, it would enable users to easily select and/or view multiple attached objects in a short time and less interventions from the users, thereby, increasing users' conveniences and the system could be more attractive to the users.

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22. Applicant's arguments filed 2/19/04 have been considered but are moot in view of the new ground(s) of rejection.

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Bunjob Jaroenchonwanit', with a long horizontal stroke extending to the right.

Bunjob Jaroenchonwanit  
Primary Examiner  
Art Unit 2143

/bj  
9/4/04